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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/565,735

06/14/2006

Christian Hummel

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1609

7590

08/14/2009

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EXAMINER

OU, JING RUI

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/565,735	Applicant(s) HUMMEL ET AL.	
	Examiner JING OU	Art Unit 3773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-15 and 23-28 is/are rejected.
- 7) ☒ Claim(s) 16-22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the appeal brief filed on 04/28/2009 and amendment filed on 09/22/2008. Claims 11-28 are pending. Claims 1-10 are cancelled. Claims 11, 14, and 23 are independent. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 11, 12, 14, 15, 23, 24, and 26-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Sugiyama et al (US Pub. No.: 200/0177861).

In regard to Claims 11, 12, and 27, Sugiyama et al discloses a method a method for self-closing medical clips, comprising the steps of: placing a distal end of a catheter tube (130) in a body of a living being to be treated (Para.[0105]); arranging at least one self-closing medical clip (combination of 110 and 115) with relatively movable legs (two opposite arms 111) in the catheter tube adjacent the distal end by an operator located on a proximal end of the catheter tube (140), the clip having a first kink (114b) in a first area of each leg extending outwardly and increasing a distance between the legs and a second kink (114a) in a second area nearer a distal leg end of the clip than the first area but spaced from the distal leg end extending inwardly and forming a point of mutual

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support for the legs (Figs. 5 and 9); pushing the clip out of the distal end (Figs. 2 and 11); opening the clip by an actuator (combination of 131, 134, 120, and 135) having an actuating element (131 and 134) acting on the clip, being movable longitudinally in the catheter tube, being actuated by the operator and having a control part (120) converting an actuating force of the actuating element into a motion opening the legs of the clip (Para.[0101]); and detaching the actuating element from the clip after opening of the clip to release and close the legs of the clip to apply the clip (Para.[0108]); wherein the legs of the clip are symmetrical, are mirror images of one another and do not cross one another (Fig. 15);

In regard to Claims 14, 15, 23, 24, 26, and 28 Kobayashi et al discloses a device comprising: a catheter tube (130) having a distal end placeable in the body and a proximal end placeable outside the body; an operator at said proximal end (140); an actuator (combination of 131, 134, 120, and 135) extending in said catheter tube from said operator in an area adjacent said distal end, having an actuating element (131 and 134) movable longitudinally in said catheter tube and controlled by said operator, and having at least one control part (120 and 135) with a distal end edge on a sleeve-shaped receiving part (120); and at least one clip (combination of 110 and 115) adjacent to and directly engaging said distal end edge and having a part (Fig. 7) received in said actuating element and two adjacent legs (two opposite arms 111), said legs having first kinks (114b) extending outwardly and increasing a distance between said legs in first areas of said legs and second kinks (114a) extending inwardly and forming a mutual support for said legs in second areas of said legs nearer to a distal leg end of said clip

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than said first area, but spaced from said distal leg end without said legs crossing one another (Fig. 9); whereby said legs are opened by said first kinks engaging said control part when said clip is inserted into said sleeve-shaped receiving part which converts an actuating force of said actuating element into an opening motion of said legs with said second areas engaging one another (Para.[0101]); wherein said actuating element comprises a pulling element (131); and said distal end edge comprises a beveled control surface (Fig. 28, the open-close ring 120 has beveled surface at its distal end edge); wherein said pulling element comprises a pull cable; and said clip is connected to said pull cable by a rear end crosspiece (115) connecting said legs of said clip, said rear end crosspiece having two adjacent through holes (Fig. 9, string 115 has two adjacent holes).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 13 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugiyama et al (US Pub. No.: 200/0177861) in view of Kobayashi et al (US Pub. No.: 2002/0128667).

In regard to Claims 13, Sugiyama et al discloses all the limitations of the claim but fails to disclose a plurality of other clips, similar to the one clip, are arranged in succession in the catheter tube; and after application of the clip at the distal end of the catheter tube, the actuating device is functionally linked to the clip next following in the catheter tube.

However, Kobayashi et al teaches a method of self-closing medical clips comprising: a plurality of other clips, similar to the one clip, are arranged in succession in the catheter tube (Figs. 21A-21D); and after application of the clip at the distal end of the catheter tube, the actuating device is functionally linked to the clip next following in the catheter tube.

Sugiyama et al and Kobayashi et al are analogous art because they are from the same field of endeavor.

At the time of the invention, it would have been obvious to one of ordinary skill in the art, having the teachings of Sugiyama et al and Kobayashi et al before him or her, to modify the method of Sugiyama et al to include a plurality of other clips, similar to the one clip, are arranged in succession in the catheter tube (Figs. 21A-21D); and after application of the clip at the distal end of the catheter tube, the actuating device is functionally linked to the clip next following in the catheter tube as taught by Kobayashi et al.

The suggestion/motivation for doing so would have been to apply multiple clips inside the body without withdrawing the introducing tube (Kobayashi et al, Para. [0007])

Therefore, it would have been obvious to combine Kobayashi et al with Sugiyama et al to obtain the invention as specified in the instant claim.

In regard to Claim 25, Sugiyama et al discloses all the limitations of the claim but fails to disclose a predetermined breaking point extending between two adjacent through holes.

However, Kobayashi et al teaches a predetermined breaking point extending between two adjacent holes (Fig. 7C).

At the time of the invention, it would have been obvious to one of ordinary skill in the art, having the teachings of Sugiyama et al and Kobayashi et al before him or her, to modify the apparatus of Sugiyama et al to include a predetermined breaking point extending between two adjacent holes as taught by Kobayashi et al.

The suggestion/motivation for doing so would have been break the ligating wire / string easier at a predetermined location on the ligating wire / string (Kobayashi et al, Para.[0091] and Fig. 7C)

Therefore, it would have been obvious to combine Kobayashi et al with Sugiyama et al to obtain the invention as specified in the instant claim.

Allowable Subject Matter

8. Claims 16-22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

9. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

10. Applicant's arguments with respect to claims 11-15 and 23-28 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JING OU whose telephone number is (571)270-5036. The examiner can normally be reached on M-F 7:30am - 5:00pm, Alternative Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Uyen (Jackie) T Ho can be reached on (571)272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/(Jackie) Tan-Uyen T. Ho/

Supervisory Patent Examiner, Art Unit 3773